REMARKS

Claims 1, 3, 4, and 6-12 are currently pending in the present application. Claims 2 and 5 remain cancelled. Claims 1, 7, and 10 have been amended. Claims 11 and 12 have been added. Support for the amendments to claim set can be found at paragraph [0025] of Applicants' published application. No new matter has been added by any of the amendments.

Applicants have carefully studied the outstanding Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested. Applicants respectfully request reconsideration and withdrawal of the Examiner's rejections in view of the foregoing amendments and following remarks.

Claim Rejections -35 USC § 102

Claims 1, 3, 4, and 7-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Moriya et al., U.S. Patent 5,821,315 (hereinafter "Moriya").

Applicants' Response:

Applicants respectfully traverse this rejection for the following reasons. Claims 1 and 7 have been amended to better reflect the invention. As noted by the Examiner, Moriya discloses a compound A3, which comprises PURAKUSERA (PLACCEL) FM-2, which is the reaction product of 2 mol ε-caprolactone and 1 mol of 2-hydroxyethyl methacrylate. A3 has a hydroxyl group value of 140 mgKOH/g and the molecular weight of 10,000, as further noted by the Examiner with reference to Table 2 of Moriya. However, Moriya fails to disclose, teach, or suggest the claimed lactone polyol (C), as recited in amended independent claims 1 and 7. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element

of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Consequently, for at least this reason, Applicants respectfully request reconsideration and withdrawal of the anticipation rejection of independent claims 1 and 7 and their dependent claims 3-4 and 8-9, respectively.

Claim Rejections – 35 USC § 103

Claims 6 and 10 have been rejected under 35 U.S.C. § 103(a) as being obvious over Moriya. Claims 1, 3, 4, and 7-9 have also been rejected under 35 U.S.C. § 103(a) as being obvious over Hayakawa et al., WO 96/34064 (hereiniafter "Hayakawa").

Applicants' Response:

Applicants respectfully traverse the rejections under 35 U.S.C. § 103(a) for the following reasons. Applicants will first address the rejections made to claims 1, 3-4 and 7-9 in view of Hayakawa. As reflected by the amendments to claims 1 and 7, the present invention is directed towards a coating composition comprising a (meth) acrylic resin (A) having a hydroxyl group, which is obtained by copolymerizing a mixture having for its essential components a polycaprolactone-modified hydroxyalkyl (meth) acrylate and a different hydroxyl-group containing (meth) acrylate, a polyisocyanate compound (B) having a plurality of isocyanate groups, and a lactone polyol (C) having three or more hydroxyl groups per molecule. The hydroxyl group of the hydroxyl group-containing (meth) acrylate is a primary hydroxyl group, and the hydroxyl number of the (meth) acrylic resin (A) is 125 to 145 mgKOH/g. Further, the average molecular weight of the lactone polyol (C) is 350 to 1500.

Hayakawa discloses thermoset paint compositions including fluorine containing copolymer, vinyl based copolymer, alkyl etherified melanine resin, and polyisocyanate

compound. However, Hayakawa fails to disclose and teach the claimed feature in which a lactone polyol (C) has three or more hydroxyl groups. Further, Hayakawa also fails to disclose, teach, or suggest that the claimed average molecular weight of the lactone polyol is 350 to 1500, as recited in the amended claims. Consequently, for at least these reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 3-4 and 7-9 in view of Hayakawa.

With regard to claims 6 and 10, as previously stated, Applicants have amended claims 1 and 7, upon which claims 6 and 10 depend, to better reflect the invention. Neither Moriya nor Hayakawa, either alone or in combination, disclose, teach, or suggest the invention as recited in novel and non-obvious independent claims 1 and 7. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *see also* MPEP 2143.03. All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Consequently, for at least this reason, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 6 and 10 under § 103(a) and allowance of the application.

CONCLUSION

It is respectfully urged that the subject application is patentable over the references cited by Examiner and is now in condition for allowance. Applicants request consideration of the application and allowance of the claims in view of the foregoing amendments and remarks. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Colin P. Cahoon or Celina M. Diaz at 972-367-2001.

The Commissioner is hereby authorized to charge any additional payments that may be due for additional claims to Deposit Account 50-0392.

Respectfully submitted,

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